

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application.

Claims 10 and 20 have been amended.

5 **Claims 1, 2, 4-12, 14-20 are pending.**

Claims 10 and 20 were objected to as being dependent upon rejected base claims, but were deemed allowable if rewritten in independent form. Claims 10 and 20 have been rewritten in independent form and are therefore allowable.

10 **Claims 1, 2, 4, 6-9, 11, 12, 14, 16-19** stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,696,894 issued to Ono (hereinafter, "*Ono*") in view of U.S. Patent No. 6,000,864 issued to Hanada (hereinafter, "*Hanada*").

15 The Applicant respectfully traverses these rejections for at least the following reasons.

Ono discloses a printing system in which a computer is connected through a wireless link to one or more printers. The computer selects a printer to handle a print job, for example, based on printer status, desired print speed, etc. The computer then sends print job data to the selected printer over the wireless link.

20 As admitted in the Office Action, *Ono* does not disclose or otherwise suggest using a wireless communication device to selectively transmit printing device control information to a printing device over a wireless communication interface.

25 *Hanada* discloses a system in which a digital still camera provides print job data to a printer over an infrared link. The printer is configured to identify when it is ready to receive the print job data from the digital still camera. The

Office Action alleges that the digital still camera of *Hanada* teaches the claimed wireless communication device missing from *Ono*.

More specifically, the Office Action alleges that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of *Hanada* into the teachings of *Ono* because it would provide a portable and convenient interface in a wireless environment.

The Applicant disagrees with this allegation.

One important factor to consider is the type of data being transmitted to the printer over the wireless link. Note that in both of these references, print job data is sent to the printer over the wireless link. In the pending method and apparatus claims, printing device control information that includes network configuration information associated with a printing device is being transmitted to the printing device over the wireless link.

Another important factor to consider is what the transmitted data is used for in the printer. In both *Ono* and *Hanada* the transmitted data is print job data that results in a print out. In the pending method and apparatus claims, the printing device control information includes network configuration information associated with the printing device. For example, this is how a printer may be programmed to properly work in a network environment (wired and/or wireless).

Since neither *Ono* nor *Hanada* discuss how their printers are initially configured with network configuration information to properly work within a networked environment, one can only assume that they intended to configure their printers for use in a network using standard and conventional techniques available at the time, such as, for example, having an administrator manually program the printer through its front panel interface prior to having the printer connect to the network.

Another important factor to consider is that a digital still camera as described in Hanada back in 1997 did not have any additional functionality normally associated with portable communication devices. While at the time of this Amendment, there is recent trend in mobile communications to incorporate digital still camera features in mobile telephones, this was not the case back in 1997 when Hanada invented and/or in June of 2000 when the present application was filed. Thus, there is simply no evidence that Hanada's digital still camera is a portable communication device as recited in the pending claims.

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

Given the exemplary factors described above, there is no reason or suggestion to be found in *Ono* or *Hanada* whereby a person of ordinary skill in the field of the invention would have been motivated to substitute a wireless communication device in the place of *Ono*'s computer and/or *Hanada*'s digital still camera. Especially a wireless communication device in which printing device control information that includes network configuration information associated with a printing device is maintained, and the wireless communication device selectively transmits the printing device control information to a printing device over a wireless communication interface, for example, as recited in independent Claim 1.

As described above, both *Ono* and *Hanada* only teach that print job data is transmitted to the printer. *Ono*'s computer is configured to monitor printer resources and select an applicable/capable printer for the print job. *Hanada*'s digital still camera is configured to monitor a printer resource and selectively send its captured digital image to the printer once the printer has warmed up

and is ready to accept the print job. Hence, the resulting print job data does not include printing device control information having network configuration information associated with a printing device as recited in Claim 1.

Furthermore, while the digital still camera in *Hanada* includes a wireless link (infrared), it seems doubtful that a person of ordinary skill in the field of the invention would have been motivated to substitute a wireless communication device in its place, especially a wireless communication device that maintains and transmits printing device control information.

Ono and *Hanada* are solving the problem of interfacing with a printer based on status information received over the wireless link from the printer and selectively sending print job data to the printer in some smart way. For *Ono*, this clearly requires that the printer be configured with network configuration information in advance to establish the requisite wireless link with the computer.

Consequently, neither *Ono* and/or *Hanada* disclose or even reasonably suggest the method of Claim 1, and/or the methods recited in dependent Claims 2, 4, and 6-9 which depend therefrom.

Also contrary to the teachings of *Ono* and/or *Hanada*, is independent Claim 11 which is directed towards an arrangement that includes a wireless communications device having logic that is configured to maintain printing device control information, and a communication interface operatively coupled to the logic and configurable to selectively transmit a wireless signal having at least a portion of the printing device control information therein. Here, the printing device control information includes network configuration information associated with a printing device.

For at least the factors/reasons stated above with regard to Claim 1, neither *Ono* and/or *Hanada* disclose or even reasonably suggest the

arrangement of Claim 11 and/or dependent Claims 12, 14 and 16-19 which depend therefrom.

Dependent Claims 5 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ono* in view of *Hanada* and in further view of U.S.

5 Patent No. 5,237,663 issued to Srinivasan (hereinafter, "*Srinivasan*").

The Applicant respectfully traverses these rejections for at least the factors/reasons stated above with regard to independent Claims 1 and 11, and/or the following additional reasons.

Srinivasan discloses using a handheld computing system (e.g., a handheld
10 computer, calculator) to diagnose/configure a computer system through a wireless interface. *Srinivasan* does not disclose or otherwise suggest using a wireless communication device. The Office Action alleges that *Srinivasan* discloses or suggests that the handheld computing system may include a "PDA".

This allegation seems completely off point given that Claim 5, which
15 depends from Claim 1, further recites that the wireless communication device includes a wireless telephone or a pager, and Claim 15, which depends from Claim 11, further recites that the wireless communication device includes a wireless telephone or a pager.

Thus, neither *Ono*, *Hanada* and/or *Srinivasan*, alone or combined,
20 disclose or suggest the method recited in Claim 5 or the arrangement recited in Claim 15 wherein the wireless communication device includes a wireless telephone or a pager.

Conclusion

The pending claims are each clearly patentable over the cited art and as such are in condition for prompt allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application.

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Respectfully Submitted,

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